

Express Mail Label
EPO EV 432653132 US

05-21-04

SMX 3071.1(99-22R1)
PATENT

17w
1639



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Keith Hall et al.
Serial No. 09/817,821
Filed March 26, 2001
Confirmation No. 7846

Art Unit 1639

For COMBINATORIAL SYNTHESIS AND ANALYSIS OF METAL-LIGAND
COMPOSITIONS USING SOLUBLE METAL PRECURSORS

Examiner My-Chau T Tran

May 20, 2003

**RESPONSE TO THIRD
ELECTION OF SPECIES REQUIREMENT**

TO THE ASSISTANT COMMISSIONER FOR PATENTS,

SIR:

In response to the Office action of April 21, 2003, wherein a third Election of Species was requested, Applicants hereby elect, for the purpose of conducting a search, a method wherein formation of one or more of the metal-ligand compositions is accompanied by the displacement of a solublizing ligand from the soluble metal precursor used therein. Claims reading on the elected species include claims 90-112.

However, Applicants respectfully traverse the present Election of Species Requirement on the basis that, consistent with MPEP §803, to search and examine the subject matter of both independent claims 1 and 90, as well as all claims depending therefrom, does not place a serious burden on the Office.¹ In fact, Applicants respectfully submit the subject matter of claim 1 and claim 90 has already been searched and examined in view of the following:

- - - - -

¹ "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent and distinct inventions." MPEP §803.